

REMARKS

The Office Action mailed December 2, 2004, has been received and reviewed. Claims 26, 28-29, 37, 38, 40-44, 47, 48 and 49 having been canceled, the pending claims are claims 1-5, 21-25, 45, 46 and 50. Reconsideration and withdrawal of the objections and rejections are respectfully requested.

Per the Examiner's request paragraphs on pages 26, 72 and 73, beginning at lines 14, 30 and 26, respectfully, of the instant application have been amended to remove embedded hyperlinks, and paragraphs on pages 36 and 58, beginning at lines 16 and 34, respectfully, have been amended to properly reference the use of trademarks.

Priority

Applicants respectfully disagree with the Examiner's assertion that Applicants' Amendment mailed September 23, 2004 introduced new matter. Applicants are confused by the Examiner's statement regarding an October 15, 2002 Amendment. Applicants do not believe that they submitted an Amendment to the Office in October 2002. In order to expedite prosecution of the instant application, however, Applicants have canceled claims 26, 28-29, 37, 38, 40-44, 47, 48 and 49, thereby rendering the Examiner's introduction of new matter assertion moot. Accordingly, withdrawal of this rejection is respectfully requested

Objection to the Specification

The Examiner objected to the specification for containing embedded hyperlinks and failing to reference trademarks properly. Applicants have amended the specification to remove the hyperlinks and capitalize trademarks and following same with the appropriate symbol. The Examiner also objected to the specification for allegedly adding new matter into the disclosure of the application. This assertion is discussed above. Accordingly, withdrawal of the objection to the specification is respectfully requested.

Rejections Under 35 U.S.C. §112, First Paragraph

The Examiner rejected claims 26, 28-29, 37-38 and 40-43 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is respectfully traversed.

As claims 26, 28-29, 37-38 and 40-43 having been canceled, Applicants submit that the Examiner's rejection has been rendered moot. Accordingly, withdrawal of the rejection is respectfully requested.

The Examiner rejected claims 1-2, 4, 44 and 47-49 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This rejection is respectfully traversed.

Applicants wish to point out that the enablement requirement is not precluded by the necessity for some experimentation, such as routine screening. The key word is "undue" not "experimentation." In re Angstadt, 190 USPQ 214, 219 (CCPA 1976). A considerable amount of experimentation is permissible if it is merely routine, or if the specification provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed. In re Jackson, 217 USPQ 804 (Bd. App. 1982).

Applicants respectfully submit that one of skill in the relevant art would be able to make and use the invention as claimed, as the skilled artisan would be able to readily screen for antimicrobial activity of a variant of a zamp1 polypeptide of the present invention. Thus, upon reading the specification, one of skill in the art would know how to make and use a zamp1 polypeptide of the present invention without undue experimentation. Here the Examiner has offered no reason to doubt the truth of the statements in the specification.

Because a reasonable basis to question the enablement provided for the claimed invention was not provided in the Office Action, the burden of proof under 35 U.S.C. §112, first paragraph has not been satisfied, and a *prima facie* case of lack of enablement has not been made. "A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in

describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. §112, first paragraph, unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling supports.” MPEP §2164.04. Reasons for uncertainty of the enablement are required even when there is no evidence in the record of operability without undue experimentation beyond the disclosed embodiments.

Accordingly, reconsideration and withdrawal of the rejection of claims 1-2, 4, 44 (now canceled) and 47-49 (now canceled) under 35 U.S.C. §112, first paragraph, are respectfully requested.

Rejection Under 35 U.S.C. §112, Second Paragraph

The Examiner rejected claim 44 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This rejection is respectfully traversed.

As Applicants have canceled claim 44, the Examiner’s rejection is rendered moot. Accordingly, withdrawal of the rejection under 35 U.S.C. §112, second paragraph, is respectfully requested.

Double Patenting Rejection

Claim 50 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 64 of copending U.S. Patent Application Serial No.10/409,366. Upon an indication of otherwise allowable subject matter and in the event this rejection is maintained, Applicants will provide an appropriate response.

Claims 1-5, 21-26, 28-29, 37-38 and 40-50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 26-43 and 45-90 of copending U.S. Patent Application Serial No. 10/272,121. Upon an indication of otherwise allowable subject matter and in the event this rejection is maintained, Applicants will provide an appropriate response.

Claims 1-5, 21-26, 28-29, 37-38 and 40-50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 26-65 of copending U.S. Patent Application Serial No. 10/409,366. Upon an indication of otherwise allowable subject matter and in the event this rejection is maintained, Applicants will provide an appropriate response.

Summary

It is respectfully submitted that claims 1-5, 21-25, 45, 46 and 50 are in condition for allowance, and notification to that effect is earnestly solicited. The Examiner is invited to contact Applicants' Agent at (206) 442-6540, if it is believed that prosecution of this application may be assisted thereby.

Respectfully Submitted,



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Enclosures:

Petition and Fee for Extension of Time (in duplicate)
Amendment Fee Transmittal (in duplicate)
Postcard